REMARKS/ARGUMENTS

In the Office Action mailed June 25, 2008 (hereinafter, "Office Action"), claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103. Claims 1, 12, and 21 have been amended. Applicants respectfully respond to the Office Action.

I.   Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 Rejected Under 35 U.S.C. § 103

Claims 1-4, 8, 9, 11-14, 18, 19, 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,142,318 to Lopez et al. (hereinafter, "Lopez") in view of U.S. Patent No. 7,173,724 to Nomura et al. (hereinafter, "Nomura"). Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

Claim 1, as amended, recites "printing a proof sheet by the scanner, wherein said proof sheet is representative of the scan job" and that "if the proof sheet is acceptable, the user can accept the scan job with modifying the proof sheet." Support for this claim language can be found throughout

Applicants' specification on at least pages 5- 7 and Figures 3-5. Lopez, alone or in combination with

Nomura, does not teach or suggest this subject matter.

The Office Action is apparently relying upon Lopez to allegedly teach the claimed "proof

sheet." As explained in the prior Office Action, Lopez states:

> Referring now to the drawings, there is illustrated a printing system
> constructed in accordance with the present invention which enables digital
> images associated with Internet web pages to be previewed, selected, and
> printed without the need for a computer attached to the printer. The printing
> system preferably includes subsystems which obtain certain image files
> associated with a specified web page, print a proof sheet associated with
> those images, allow the user to select which of the images are to be printed,
> and print these user-selected image files.

Lopez, col. 3, lines 40-49.

Lopez thus describes "digital images associated with Internet web pages" and "print[ing] a

proof sheet associated with those images." Lopez further states that "the proof sheet 22 includes an

indicia 52 (such as a thumb-nail image and/or a filename) for each qualified image file 3, and a user-

designation area 54 associated with each indicia 52." (Lopez, col. 4, line 66 – col. 5, line 2).

Lopez also states:

> After the user chooses selected ones of the qualified image files 2 for
> printing by marking the user-designation areas 54 associated with the indicia
> 52 of the selected image files 2, the user places the marked proof sheet 22 on
> a scan platen [sic] 122 where it is optically scanned by a scanner subsystem
> 82. The proof sheet analyzer subsystem 82 detects and interprets the
> markings made by the user in the user designation areas 54 (also known as
> image selection areas 54) to identify the user-selected image files 2, and
> associates each of the individual user designation areas 54 with a
> corresponding image file URL 73 via the identity marker 60. The proof sheet
> analyzer subsystem 82 then provides the image file URLs 73 to the internet
> access subsystem 70 in order to obtain the user-selected image files 2 from
> the network 205. When the image files 2 have been retrieved, the proof sheet
> analyzer 82 sends them to an image printing subsystem 84 along with the
> printing instructions marked by the user in the user-designation area 54 for
> each image file.

Lopez, col. 5, lines 8-27.

Thus, "the marked proof sheet" in Lopez is "optically scanned by a scanner subsystem" to "detect[] and interpret[] the markings made by the user in the user designation areas." Consequently, the "marked proof sheet" is printed before it is scanned by the "scanner subsystem." Therefore, the "marked proof sheet" of Lopez is not the same as the "proof sheet" of the present application, since the "marked proof sheet" of Lopez is printed before it is scanned as a "scan job." Moreover, as noted above, the "proof sheet 22" includes a designation area 54 that must be marked by the user and then scanned so that the markings can be detected and interpreted by the proof sheet analyzer subsystem 82. Thus, the user must modify the proof sheet 22, by (for example) marking it and then scanning it, before the user can accept the scan job. This is contrary to the teachings of the present claims which require that "if the proof sheet is acceptable, the user can accept the scan job with modifying the proof sheet." Accordingly, this claim language is not taught or suggested by Lopez.

The addition of Nomura does not overcome the deficiencies of Lopez. The Office Action has not cited, nor can Applicants find any mention of or reference to a "proof sheet" in Nomura. Furthermore, the Office Action has not cited, nor can Applicants find any portion of Nomura that teaches or suggests "if the proof sheet is acceptable, the user can accept the scan job with modifying the proof sheet." Nomura describes a scanner that "has an auto reading mode and manual reading mode. In the auto reading mode, sheet-shaped documents are automatically fed by the automatic document feeder 4, and scanned sheet-by-sheet to be exposed, so as to read document images." (Nomura, col. 8, lines 26-30). However, describing a scanner that can "read document images" does not teach or suggest "printing a proof sheet by the scanner," let alone the requirement that "if the proof sheet is acceptable, the user can accept the scan job with modifying the proof sheet."

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 1.

Claims 2-4, 8, 9 and 11 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-4, 8, 9 and 11 be withdrawn.

Claims 12 and 21 include subject matter similar to the subject matter of claim 1. Accordingly, Applicants respectfully request that the rejection of claims 12 and 21 be withdrawn for at least the same reasons as those presented above in connection with claim 1.
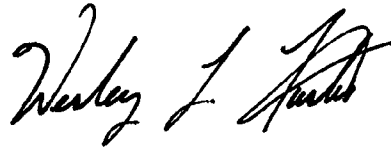
Claims 13, 14, 18 and 19 depend either directly or indirectly from claim 12. Claims 22, 23, 27 and 28 depend either directly or indirectly from claim 21. Accordingly, Applicants respectfully request that the rejection of claims 13, 14, 18, 19, 22, 23, 27 and 28 be withdrawn.

II.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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Date: September 25, 2008

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